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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WENDEROTH LIND & PONACK
2033 K STREET NW
SUITE 800
WASHINGTON, DC 20006

EXAMINER

FLANDERS, ANDREW C

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 10/13/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/423,389

Applicant(s)

KATAOKA, MITSUTERU

Examiner

Andrew C Flanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 8 -11, 16, and, 23 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (U.S. Patent 5,926,624) in view of Richter (U.S. Patent 5,623,490).

3. Regarding Claims 1, 16, 23, and 27, Katz discloses that encrypted and compressed digital information files are received by a client computer system from a library server over a network (col. 9 lines 43 – 45) (i.e. receiving means for receiving program data provided through broadcasting), storage for encrypted and compressed digital information files (col. 9 lines 21 and 22) (i.e. primary storing means for storing the program data received by said receiving means), a mobile device interface that is a software interface used to control the transfer of digital information files from the client computer system to the mobile playback device (col. 9 lines 39 – 42) (i.e. transferring means for discretely, to said portable device, each of the program components of the program data stored in said primary storing means in the direction of a time axis), a mobile playback device that contains a limited quantity of non-volatile memory, RAM, and ROM which stores digital information content (col. 10 lines 41 – 43) (i.e. secondary storing means for storing the program components to be discretely transferred from said

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transferring means) and that digital information output may be provided via a headphone jack, on board speaker or wireless transmitter to a separate wireless receiver with speakers or headphones (col. 10 lines 33 – 36). If you take digital information and output it to an audio output device such as a speaker or headphones, at some point the digital information must be converted into the analog domain. This can be done with a D/A converter or various other ways (i.e. re-constructing means for re-constructing program data included in any program desired to play-back from the program components stored in said secondary storing means and playing-back means for playing-back the program data re-constructed by said re-constructing means). Katz does not disclose any transfer priority assigning means for assigning transfer priorities to every program component constituting the program data stored in said primary storing means or transferring in the order of said assigned transfer priorities. Richter discloses each data type packet at the transmitter is assigned a priority between 0 and 10000, with 0 being the highest priority and 10000 the lowest (col. 2 lines 23 – 25) and before transmission on the communication channel, packets are placed in a queue according to priority order (col. 2 lines 30 and 31) (i.e. transfer priority assigning means for assigning transfer priorities to every program component constituting the program data stored in said primary storing means and transferring in the order of said assigned transfer priorities). One of ordinary skill in the art would have been motivated to use Katz system in conjunction with Richter's transferring scheme in order to ensure reliable data transfer. According to this system, the data with the highest priority will always be sent first and thus available to the user.

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4. Regarding Claims 8 and 24, in addition to the elements stated above regarding claims 1 and 23, Katz further discloses that a user controls the mobile playback device using buttons and knobs provided on the device and that these controls are used to navigate through the digital information files and adjust playback parameters (col. 10 lines 22 – 26). Furthermore, when a user is navigating through the digital information files as one media clip is playing and the user selects another midway, that clip will cease to play and the next clip will begin (i.e. wherein when any data of the program component of the program data re-constructed by said re-constructing means is discontinued halfway during play-back by said playing-back means, said portable device further comprises replacing means for having any other program component being not currently played-back to play-back as a replacement).

5. Regarding Claims 9 and 25, in addition to the elements stated above regarding claims 8 and 24, Richter further discloses at the receiver, each task runs according to its assigned priority, packets with priorities between 0 and 100 are processed first (col. 2 lines 33 – 36) (i.e. presentation priority defining means for previously defining presentation priorities to each type of said program components) and audio, being the highest priority is processed first to the exclusion of all other packets (col. 2 lines 37 and 38) (i.e. said replacing means determines a program component to play-back as a replacement in accordance with the definition provided by said presentation priority defining means).

6. Regarding Claims 10 and 26, in addition to the elements stated above regarding claims 9 and 25, Richter discloses each data type packet at the transmitter is assigned

a priority between 0 and 10000, with 0 being the highest priority and 10000 the lowest (col. 2 lines 23 – 25), that an audio packet is given priority 20 and a video packet 50 (col. 2 lines 25 and 26) (i.e. wherein types of the program components are classified into a plurality of classes by said presentation priority defining means). Katz further discloses that a user controls the mobile playback device using buttons and knobs provided on the device and that these controls are used to navigate through the digital information files and adjust playback parameters (col. 10 lines 22 – 26). Furthermore, when a user is navigating through the digital information files as one media clip is playing and the user selects another midway that clip will cease to play and the next clip will begin (i.e. said replacing means determines a program component to play-back as a replacement among the program components belonging to the same class as does said program component discontinued during play-back).

7. Regarding Claim 11, in addition to the elements stated above regarding claim 1, Katz further discloses the mobile playback device includes an interface to the client computer system over which compressed digital information files are received (col. 10 lines 15 –19) (i.e. wherein said main device and said portable device are structured to be electrically interconnectable, and said transferring means online-transfers each program component of the program data stored in said primary storing means directly to said portable device).

8. Claims 12 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (U.S. Patent 5,926,624) in view of Richter (U.S. Patent 5,623,490) and in further view of Kono (U.S. Patent 5,914,706).

9. Regarding Claim 12, in addition to the elements stated above regarding claim 11, Katz further discloses the mobile playback device includes an interface to the client computer system over which compressed digital information files are received (col. 10 lines 15 –19) (i.e. attaching means for allowing said portable device to be electrically connected). Katz does not disclose charging means for supplying power to charge said portable device when the portable device is attached to said attaching means, wherein said portable device further comprises a battery to be charged by the power supplied from said charging. Kono discloses a power unit that provides a power connection to a DC power source such as a standard or rechargeable battery (col. 10 lines 8 and 9) (i.e. charging means for supplying power to charge said portable device when the portable device is attached to said attaching means, wherein said portable device further comprises a battery to be charged by the power supplied from said charging). One of ordinary skill in the art at the time of the invention would have been motivated to add Kono's charging mechanism to Katz portable device in order to increase mobility and reduce the need to repeatedly purchase costly batteries. With a rechargeable battery system, one would not need to be tethered to a power cable and thus be free to move about and one would not need to keep purchasing new batteries as the old died.

10. Regarding Claim 13, in addition to the elements stated above regarding claim 12, Kono further discloses that it is possible to record new data on an optical medium employing either an erasable type magnet-optical medium or a write once type medium, supplied from an external database (col. 8 lines 34 – 37) (i.e. wherein said transferring

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means offline-transfers each program component of the program data stored in said primary storing means to said portable device through a recording medium).

11. Regarding Claim 14, in addition to the elements stated above regarding claim 13, Kono further discloses that it is possible to record new data on an optical medium employing either an erasable type magnet-optical medium or a write once type medium, supplied from an external database (col. 8 lines 34 – 37) (i.e. wherein said main device further comprises writing means for writing any program component to be transferred to said portable device into said recording medium) and accessing the drive for a ass memory medium such as a CD (col. 5 lines 17 – 19) (i.e. said portable device further comprises reading means for reading the program component recorded in said recording medium).

12. Regarding Claim 15, in addition to the elements stated above regarding claim 14, Katz further discloses the present invention includes a library site coupled to a client site via a conventional distribution network infrastructure. This conventional distribution network infrastructure can be implemented as a standard telephone connection provided between the library site and client site through an Internet provider to enable data communication on the Internet (col. 4 lines 44 – 50) (i.e. wherein said receiving means receives program data through a computer network).

4. Claims 2 – 6, 17 - 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (U.S. Patent 5,926,624) in view of Richter (U.S. Patent 5,623,490) and in further view of Ueda (U.S Patent 5,835,789).

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5. Regarding Claims 2 and 17, in addition to the elements stated above regarding claims 1 and 16, Ueda discloses that when data including characters, images and music is transmitted, it is desirable to first send what is smaller in amount of data (col. 17 lines 26 – 29). It is inherent that in order to send smaller files before larger files, the files must be placed in order from smallest to largest, in other words, assigning a transfer priority based on size (i.e. wherein said transfer priority assigning means assigns transfer priorities to each of the program components in such a manner that a program component with less amount of data has a higher transfer priority). One of ordinary skill in the art at the time of the invention would have been motivated to use Katz system in conjunction with Richter and Ueda transferring schemes in order to ensure reliable data transfer. By first sending what is small in amount of data, when communication is interrupted, the possibility that a great amount of information has arrived is high (Ueda col. 17 lines 32 – 34).

6. Regarding Claims 3 and 18, in addition to the elements stated above regarding claims 2 and 17, Richter further discloses that an audio packet is given priority 20 and a video packet 50 (col. 2 lines 25 and 26) (i.e. transfer priority defining means for previously defining transfer priorities by default to every type of said program components, and said transfer priority assigning means assigns, in accordance with a definition provided by said transfer priority defining means, said transfer priorities by default to each of the program components).

7. Regarding Claims 4 and 19, in addition to the elements stated above regarding claims 3 and 18, Katz further discloses a computer system further including logic for

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downloading a portion or all of said targeted digital information files to said mobile device (col. 18 lines 60 –63) (i.e. wherein when the plurality of program data stored in the said primary storing means is collectively transferred to said portable device). Katz does not disclose said transferring means selects any program component having the same transfer priority from each of the program data, combines the selected program components into a unit, and then discretely transfers the combined unit in the direction of the time axis in order of the transfer priorities assigned to every combined unit.

Richter further discloses that as new packets are generated, the queue (unit) is reorganized so that the new packet is placed into its proper priority order (col. 2 lines 31 – 33). As it was shown above, all audio packets contain a priority of 20 therefore it is obvious that as they are generated, they would all be placed together within the queue before being transferred (i.e. said transferring means selects any program component having the same transfer priority from each of the program data, combines the selected program components into a unit, and then discretely transfers the combined unit in the direction of the time axis in order of the transfer priorities assigned to every combined unit).

8. Regarding Claims 5 and 20, in addition to the elements stated above regarding claims 4 and 19, Richter discloses each data type packet at the transmitter is assigned a priority between 0 and 10000, with 0 being the highest priority and 10000 the lowest (col. 2 lines 23 – 25), that an audio packet is given priority 20 and a video packet 50 (col. 2 lines 25 and 26) (i.e. wherein types of the program components are classified into a plurality of classes by said transfer priority defining means) and as new packets

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are generated, the queue (unit) is reorganized so that the new packet is placed into its proper priority order (col. 2 lines 31 – 33) (i.e. said transfer priority assigning means checks every class for the transfer priorities by default assigned to each of the program components, and then changes, in accordance with a result of the check, the transfer priorities by default assigned to each of the program components on a class basis, as required)..

9. Regarding Claims 6 and 21, in addition to the elements stated above regarding claims 5 and 20, Richter discloses that an audio packet is given priority 20 and a video packet 50 (col. 2 lines 25 and 26) and as new packets are generated, the queue is reorganized so that the new packet is placed into its proper priority order (col. 2 lines 31 – 33). Therefore, if there are no audio packets with a priority of 20 but numerous video packets of 50, the video packets will be moved to the top of the queue as it is reorganized (i.e. wherein when no program component in the same class has a value defined as being top transfer priority therein, said transfer priority assigning means changes a value of a program component being currently the highest transfer priority in the class to the value defined as being top therein).

10. Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (U.S. Patent 5,926,624) in view of Richter (U.S. Patent 5,623,490) and in further view of Bonomi (U.S. Patent 5,577,191).

11. Regarding Claims 7 and 22, in addition to the elements stated above regarding claim 1 and 16, Bonomi discloses Video editing can be accomplished using video editing software running in a host processor, an example of such video editing software

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is Premiere from Adobe Systems, Mountain View, Calif. during editing, a host computer retrieves selected frames of compressed video data from a storage device, and provides the compressed video data to a decompression unit for both decompression and display on a display monitor the video editing software running in host processor a provides the familiar video editing functions on the decompressed video frames and returns, when needed, the edited video frames back to the storage device (col. 3 lines 63 – 67 and col. 4 lines 1 – 7) (i.e. program component generating means for generating a new program component from the program components of the program data received by said receiving means, and said storing means adds the program component newly created by said program component generating means to the program data received by said receiving means, and stores the same). One of ordinary skill in the art would have been motivated to use Bonomi's editing software on Katz's computer with Richter's transferring scheme in order to produce personal compilations of media relatively easily on one's home personal computer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C Flanders whose telephone number is (703) 305-0381. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forrester Isen can be reached on (703) 305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

acf


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER